UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,248	10/19/2000	Mitsuteru Kataoka	2000 1450A	5018

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EXAMINER
EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/691,248	KATAOKA, MITSUTERU
	Examiner	Art Unit	
	Bradley Edelman	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2005*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-37* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *15-37* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *19 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
        1.☒ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
            application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *1/3/05, 3/3/05*.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

This Office action is in response to Applicant's submission of prior art under 37 CFR 1.105 filed on January 3, 2005, and request for continued examination filed on July 30, 2004. Claims 15-37 are presented for further examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Note: Examiner has interpreted the claims giving them their broadest reasonable meaning.

1.   Claims 15, 17, 18, 21, 22, 24, 25, 28, 29, 31, 32, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Durham (U.S. Patent No. 6,330,566).

In considering claim 15, Durham discloses a storage-based broadcasting system (i.e. a World Wide Web server, col. 6, lines 55-58) for supplying a user interface to present a service (i.e. supplying web pages to present web page content), the user interface being unique to the service, which is composed of content stored in said system (i.e. the web page is unique to the web page content), said system comprising:

Transmission means for transmitting control content, in a non-executable data format, as the content in its entirety or as part of the content (i.e. HTML tags and layout information comprise "control content," which are sent via a wire or radio wave which are both non-executable formats), the control content being transmitted by said transmission means so as to generate the user interface (i.e. the tags and layout information are used to generate the web page); and

Receiving means for receiving and activating the transmitted control content so as to execute the user interface (i.e. a browser receives the content such that "the user interface (e.g., a web page) is presented to the client," see col. 10, lines 35-36), wherein the user interface is transmitted by said transmission means as the control content and received by said receiving means as at least part of the content (i.e. the web page is transmitted to the client and received by the browser as at least part of the content). See col. 9, line 53 – col. 10, line 11, describing that the server creates a web page to be transmitted to the client.

In considering claim 17 Durham further discloses that the transmission means comprises:

Content pitching (i.e. sending) means for sending the content including the control content (inherent in a server that sends a web page to a client);

Service property information transmitting means for transmitting property information for indicating properties of the service (col. 10, lines 17-46, wherein user

profile information indicates how to display a particular service, such as news

information); and

Wherein the receiving means receives the transmitted property information and

determines, based on the content and the service property information, the control

content from among the received content (i.e. the client receives the news content along

with the display information and necessarily determines the two contents to display the

information to the user; col. 10, lines 17-59).

In considering claim 18, Durham further discloses the content sending means

adds to the content a content header for defining the content (inherent in order to send

the content from the client to the server), and the receiving content uses the header to

determine the control content from the rest of the received content (also inherent, since

the client must read the header to process the information).

In considering claim 21, Durham further discloses that the content sending

means comprises content ID space management means for sending information for

defining a part of an ID space of the content, and the receiving means comprises

designation means for designating the control content based on a content ID included in

the defined part of the ID space (col. 10, lines 13-46; Fig. 4, wherein the cookie contains

appropriate ID information to be used by both the sender and the receiver to define the

layout and presentation of web information to the client).

In considering claim 22, claim 22 presents a method for performing the same steps described in claim 15. Therefore, claim 22 is rejected for the same reasons stated with regard to claim 15.

In considering claim 24, claim 24 presents a method for performing the same steps described in claim 17. Therefore, claim 24 is rejected for the same reasons stated with regard to claim 17.

In considering claim 25, claim 25 presents a method for performing the same steps described in claim 18. Therefore, claim 25 is rejected for the same reasons stated with regard to claim 18.

In considering claim 28, claim 28 presents a method for performing the same steps described in claim 21. Therefore, claim 28 is rejected for the same reasons stated with regard to claim 21.

In considering claims 29, 31, 32 and 35, claims 29, 31, 32, and 35 present equivalent limitations to claims 15, 17, 18, and 21 and are thus rejected for the same reasons.

In considering claim 36, Durham further discloses a delivery unit to receive the content by the transmission unit and to transmit the content to the receiving unit (i.e. the

network inherently includes intermediate devices that receive the server content and transmit it along a route to the receiving unit).

In considering claim 37, Durham further discloses that the content is transmitted as a digital bit stream to the delivery unit, which transmits the content as a digital bit stream to the receiving unit (i.e. messages sent across the Internet are inherently sent as digital bit streams).

2.   Claims 15, 16, 22, 23, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Katinsky et al. (U.S. Patent No. 6,452,609, hereinafter "Katinsky").

In considering claim 15, Katinsky discloses a storage-based broadcasting system (i.e. web server that serves web pages across the Internet) for supplying a user interface to present a service, the user interface being unique to the service, which is composed of content stored in said system (i.e. supplying an webpage-embedded multimedia player to present multimedia content, see Fig. 1, col. 4, lines 6-25), said system comprising:

Transmission means for transmitting control content, in a non-executable data format, as the content in its entirety or as part of the content (i.e. the embedded multimedia player constitutes "control content," which is sent via a wire or radio wave which are both non-executable formats), the control content being transmitted by said transmission means so as to generate the user interface (i.e. the computer code that constitutes the multimedia player is transmitted and is used to generate the viewable player interface); and

Receiving means for receiving and activating the transmitted control content so as to execute the user interface (i.e. the computer code is received and is executed by a browser to display the player), wherein the user interface is transmitted by said transmission means as the control content and received by said receiving means as at least part of the content (i.e. the multimedia player is the control content and it is transmitted to the client as part of the web page content). See Fig. 1, col. 4, lines 6-25; col. 10, lines 17-25, describing the web page interface and sending the web page interface from a server to a client.

In considering claim 16, Katinsky further discloses that the control content is a browser for the content stored in said system (Fig. 1, wherein the control content is the multimedia player, which is a browser for viewing content from the server).

In considering claim 22, claim 22 presents a method for performing the same steps described in claim 15. Therefore, claim 22 is rejected for the same reasons stated with regard to claim 15.

In considering claim 23, claim 23 presents a method for performing the same steps described in claim 16. Therefore, claim 23 is rejected for the same reasons stated with regard to claim 16.

In considering claims 29 and 30, these claims present equivalent limitations as claim 15 and 16 respectively, and are thus rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 19-20, 26-27, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham, in view of Herz et al. (U.S. Patent No. 5,835,087, hereinafter "Herz").

In considering claims 19, 26, and 33 (which describe a system and method for performing the same steps), although the system taught by Durham discloses substantial features of the claimed invention, it fails to disclose the use of public keys and electronic signatures in conjunction with the control content, as claimed. Nonetheless, the use of public keys and electronic signatures in combination with control content, in systems that supply customized news and other information to users across the Internet, is well known, as evidenced by Herz (see Abstract and cols. 37-40, describing a detailed security system for controlling access to server information in a user-customized web page system). Thus, given the teaching of Herz, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a public key and electronic signatures with the system taught by Durham, so that

users can maintain their own profiles without the threat of others hacking into the

system and maliciously stealing user information or changing user settings. Therefore,

it would have been obvious to include the claimed public key and electronic signature

features, as taught by Herz, in the system taught by Durham.

In considering claims 20, 27, and 34, Herz further discloses that the key used for

authentication of the electronic signature is unique to the service (Abstract, cols. 37-40,

wherein the signature and public key are unique to a user's target profile).

Response to Arguments

Applicant's remarks submitted on June 18, 2004 contains the following factual

arguments:

a.   Durham does not disclose, suggest, or even contemplate a system or method to

convert an executable control content to be converted into and sent as a non-

executable content, as recited in claims 15, 22, and 29 (see p. 18, 2nd full paragraph of

Applicants remarks).

b.   Durham also fails to disclose or suggest transmitting both control content and

service content as one content over the same transmission path, and so Durham clearly

fails to disclose or suggest a transmission means for transmitting a control content, in a

non-executable data format, as the content in its entirety, the control content being

transmitted by the transmission means so as to generate the user interface, as claimed

in claims 15 and 29 (see p. 19, 3rd full paragraph of Applicant's remarks).

In considering claim (a), Applicant contends that Durham does not disclose, suggest, or even contemplate a system or method to convert an executable control content to be converted into and sent as a non-executable content, as recited in claims 15, 22, and 29. Examiner respectfully disagrees with this argument. First, note that the claim language does not mention "converting" and says nothing about converting executable control content into non-executable format. Nonetheless, even if the claim had included such information, Durham discloses this converting step because the Durham system sends web pages from a server to a client, which inherently includes the step of converting the executable HTML code or ASP file (see col. 7, lines 40-50) into non-executable digital bits before transmitting the information via a wireless or wired transmission medium.

In considering (b), Applicant contends that Durham also fails to disclose or suggest transmitting both control content and service content as one content over the same transmission path, and so Durham clearly fails to disclose or suggest a transmission means for transmitting a control content, in a non-executable data format, as the content in its entirety, the control content being transmitted by the transmission means so as to generate the user interface, as claimed in claims 15 and 29. Examiner respectfully disagrees with this argument. First, the claims do not mention "service content" so the question of whether or not Durham discloses service content, for the purposes of examining the claimed invention, is irrelevant. Second, Durham does in

fact disclose a transmission means (wire or radio wave) for transmitting a control

content (web page tags and other control content), in a non-executable data format (i.e.

electrical or electromagnetic signal), as the content in its entirety (the entire web page is

transmitted together), the control content being transmitted by the transmission means

so as to generate the user interface (the tags, etc. are used to generate the web page

displayed to a user). Therefore, Durham anticipates these claims.

Note: In Applicant's remarks filed on July 18, 2004, Applicant provides in depth

description of the differences between browsers, browser content, and service content

as described in Applicant's specification. See, e.g. pp. 11-12 of the remarks. However,

the only claims that recite the terms "browser" or "service content" are claims 16, 23,

and 30 (each of these claims states that "the control content is a browser"). For these

reasons, Examiner has recited new art in rejecting claims 16, 23, and 30. Because the

remainder of the claims only describe "content" more broadly, Examiner has interpreted

those claims accordingly and maintains the rejections in view of the Durham reference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Bradley Edelman whose telephone number is 571-272-

3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE
May 6, 2005